

REMARKS

The Office Action mailed March 5, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-28 were pending in the application. Claims 1, 7, and 10-26 have been amended, no claims have been cancelled or newly added. Therefore, claims 1-28 are pending in the application and presented for consideration.

This Amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Claims 1-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In reply, applicants have amended the claims to address the issues noted in the office action and submit that the pending claims are in definite form and meet the requirements of section 112, second paragraph. It should be noted that applicants have amended the term “weighting” to “weight” in view of the examiner’s confusion in this regard although the scope of the two terms are exactly the same and may be used interchangeably. As would be recognized by those skilled in the art, a weight is used to derive a weighted value for a category by typically multiplying the weight with the parameters in the category. Therefore, this amendment does not substantively change scope of these claims in any way.

Claims 1-28 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants have amended the claims to address the issues noted in the Office Action and submit that the pending claims meet the statutory requirements of 35 U.S.C. § 101 as currently interpreted based on the case law.

In the Office Action, claims 1-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,058,379 to Odom et al. (hereafter “Odom”). Applicants respectfully traverse these rejections for at least the following reasons.

It should be noted that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See generally MPEP §2131.

The pending independent claims 1, 13, and 25 recite, *inter alia*, a method (or system or user interface) for conducting an auction in which bids for an auction item are received

from bidders such that a respective composite score can be computed for each of the bids. The composite score is computed based on at least a plurality of categories as evaluation criteria for the bids. Weighted values for each of the selection categories are calculated based on weights for each of the categories and a composite score based on the weighted values is determined so that the bid having the highest composite score is automatically identified. These recited features are not disclosed or suggested by Odom.

First, nowhere does Odom teach or suggest computing a composite score based on a plurality of categories. The cited portions in the office action (col. 6, lines 27-55 of Odom) only disclose that a single non-composite value is used to determine selection of a bid. Odom teaches certain filtering criteria based on who can participate in a bid or whether a best bid can be determined including some other criteria such as a price or location. However, nowhere does Odom teach or suggest computing a composite score based on a plurality of categories as recited in the pending claims.

Second, Odom actually teaches away from the claimed computation of a composite score so that a bid can be automatically identified. Odom teaches that the step 220 of receiving bid information is followed in step 225 by a negotiation between the seller and all bidding parties to determine a best bid and, therefore, computation of a composite score to automatically identify a best bid would be rendered relatively meaningless in the manual intervention oriented auction/exchange process disclosed by Odom. See, for example, col. 6, lines 45-63 of Odom.

Therefore, since several recited features in the independent claims are not disclosed or suggested by Odom, the pending independent claims are believed to be patentable over the disclosure of Odom.

The dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

For example, claims 5-6 and 16-17 recite that at least one of the plurality of selected categories (for calculation of a composite score to evaluate a bid) relates to an evaluation of an auction participant by the sponsor of the auction. This recited feature is also not disclosed or suggested by Odom and provides an additional reason for the patentability of these claims.

In view of the foregoing amendments and remarks, applicants submit that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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